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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,966	02/14/2001	Julian Orbanes	GPH-003J	9257

21323 7590 11/10/2003

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EXAMINER

TRAN, MYLINH T

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/782,966

Applicant(s)

ORBANES ET AL.

Examiner

Mylinh T Tran

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Line 7, "other like" should be avoided.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 09/782,964. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is apparent that the elimination of an element, eliminates the functions of those elements. It is well settled, however, that omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before. See *In re Karlson*, 136 USPQ 184 (CCPA 1963). Furthermore, these claims are rejected since it was obvious to one of ordinary skill in the art to omit an element when its function was not desired; the subject matter is not patentable in absence of showing of unexpected result flowing from such omission. See *In re Wilson*, 155 USPQ 740 (CCPA 1967). In addition, omission of an element and its function where not needed is obvious. See *Ex parte Rainu*, 168 USPQ 375 (PTO Board of Appeal 1969).

Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 09/783,715. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is apparent that the elimination of an element, eliminates the functions of those elements. It is well settled, however, that omission of an

element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before. See *In re Karlson*, 136 USPQ 184 (CCPA 1963).

Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 09/783,967. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is apparent that the elimination of an element, eliminates the functions of those elements. It is well settled, however, that omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before. See *In re Karlson*, 136 USPQ 184 (CCPA 1963).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Strasnick et al. [US. 5,671,381].

As to claims 1 and 13, Strasnick et al. discloses employing a spatial paradigm to define hierarchical relationships between a plurality of data objects based at least

in part on said spatial paradigm (column 2, lines 1-30); and converting said plurality of data objects by locating each of said plurality of data objects in a virtual space, based at least in part on said spatial paradigm, to provide said plurality of data objects in a format adapted for substantially unrestricted searching by a user (column 4, line 42 through column 5, line 18).

As to claims 2, 9 and 14, Strasnick et al. also discloses employing a template related to said spatial paradigm to define said hierarchical relationships between said plurality of data objects, and performing said converting step based at least in part on said template (column 19, line 55 through column 20, line 8 and column 20, line 50 through column 21, line 45).

As to claims 3 and 15, Strasnick et al. teaches defining an appearance for each of said data objects in said plurality of data objects, said appearance containing a virtual representation of one or more elements of said data objects arranged employing said spatial paradigm (column 4, lines 42-65).

As to claims 4, 5, 16 and 17 Strasnick et al. shows employing vector and raster graphics in defining the virtual representation (column 10, lines 43-65).

As to claims 6 and 18, Strasnick et al. also shows generating for display from an adjustable viewing perspective of said user said appearance of a subset of said plurality of data objects (column 2, lines 33-60); enabling said user to navigate said data objects in a substantially unrestricted fashion (column 7, lines 19-55).

As to claims 7 and 19, Strasnick et al. teaches storing said plurality of data objects in a second data source (column 6, line 56 through column 7, line 8).

As to claims 8 and 20, Rolnik et al. demonstrates deconstructing at least one prior hierarchical relationship between said plurality of data objects and replacing said plurality of data objects with said converted format of said plurality of data objects (column 6, line 56 through column 7, line 10).

As to claim 10, Strasnick et al. also teaches comparing each of said plurality of data objects to a predetermined criterion, and establishing a hierarchical relationship between said plurality of data objects (column 8, line 62 through column 9, line 6 and column 5, line 58 through column 6, line 18).

As to claims 11 and 12, Edmark provides in response to said plurality of data objects including an advertisement, defining a graphical representation of said advertisement in said virtual space, wherein selection of said graphical representation by a user results in the display of graphical representations of data objects related to said advertisement in response to said plurality of data objects including an advertisement, defining a graphical representation of said advertisement in said virtual space, wherein said graphical representations of said data objects can be displayed on a plurality of client devices (column 9, line 1 through column 10, line 40).

Conclusion

Responses to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231. If applicant desires fax a response,

Art Unit: 2174

(703) 746-7238), may be used for formal After Final communications, (703) 746-7239 for Official communications, or (703) 746-4395 for Non-Official or draft communications. NOTE, A Request for Continuation (Rule 60 or 62) cannot be faxed.

Please label "PROPOSED" or "DRAFT" for information facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Fourth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mylinh Tran whose telephone number is (703) 308-1304. The examiner can normally be reached on Monday-Thursday from 8.00AM to 6.30PM

If attempt to reach the examiner by telephone are unsuccessful, the examiner 's supervisor, Kristine Kincaid, can be reached on (703) 308-0640,

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Art Unit: 2174

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

Mylinh Tran

Art Unit 2174

Kristine Kincaid
KRISTINE KINCAID
SUPERVISORY PATENT EXAMINER
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